

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed April 2, 2008.

In the Office Action, the Examiner objected to the drawings and the specification and rejected claims 1-4, 9-15, 20-26, and 30-32 under 35 U.S.C. § 102, and claims 5-8, 16-19, and 27-30 under 35 U.S.C. § 103.

Applicant has amended claims 1, 6-7, 10-11, 17-18, 21-22, 28-29, and 32, to clarify embodiments of the invention, and has canceled claims 5, 8-9, 16, 19-20, 27, and 30-31.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Drawing Objections

The Examiner objects to various alleged errors as to the drawings. In particular, the Examiner alleges that there are errors as to Figure 1 (numbers 121 and 122), Figure 4 (numbers 402 and 410), and Figure 10 (number 1010).

However, all these numbers are clearly shown in the drawings. These numbers for the figures were not listed in the specification. Applicant has amended paragraphs 36, 54, and 79 to include these numbers as set forth in Figure 1 (numbers 121 and 122), Figure 4 (numbers 402 and 402), and Figure 10 (number 1010), respectively.

Accordingly, Applicant respectfully requests that the Examiner withdraw this objection to the drawings.

Specification Objections

The Examiner objects to the alleged typographical errors in the specification. The Examiner alleges that Paragraph [0034] documents reference characters 110₁ (per Figure 1) as 1110₁ and that the same errors applies to reference characters 114₁ and 128₁.

Applicant respectfully disagrees and submits that the reference characters 110₁, 114₁, and 128₁ are not being documented as 1110₁, 1114₁, and 1128₁ in Paragraph [0034]. For ease of reference, Paragraph [0034] has been reproduced below.

[0034] As show in Figure 1, the health plan 100 may be coupled through the network 106 to a plurality of members 110 (**Member-1 110₁...Member -N 110_N**), a plurality of providers 128 (**Provider-1 128₁...Provider-N 128_N**), a plurality of employers 114 (**Employer-1 114₁...Employer-N 114_N**), and one or more insurance brokers 120. *Emphasis Added.*

As stated above and as illustrated in Figure 1, the reference characters reference Member-1 as 110₁, Provider-1 as 128₁, and Employer-1 as 114₁.

Accordingly, Applicant respectfully requests that the Examiner withdraw the objection to the specification.

Rejections Under 35 U.S.C. § 102 and § 103

Claims 1-4 and 9-15, 20-26, and 31-32 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Publication No. 2002/0049617 to Lencki et al. (hereinafter Lencki). Claims 5-8, 16-19, and 27-30 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Lencki in view of U.S. Publication No. 2005/0086075 to Kaehler et al. (hereinafter Kaehler).

Applicant has amended independent claims 1, 11, and 22 to clarify embodiments of the invention. Applicant respectfully submits that Lencki and Kaehler, alone or combination do not teach or suggest the limitations of amended independent claims 1, 11, and 22 and therefore cannot render obvious amended independent claims 1, 11, and 22.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

Furthermore, the Supreme Court in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966), stated: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.” MPEP § 2141. In KSR International Co. vs. Teleflex, Inc., 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” The Court further required that an explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 127 S.Ct. at 1741, quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006).

In the instant case, Applicant respectfully submits that there are significant differences between the Lencki and Kachler references and the amended claims and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness can be properly made.

To begin with, Lencki does not describe, either expressly or inherently, at least: a defined contribution management software module integrated with the health plan management software module, both the health plan management and defined contribution software modules operable by the claim processing system to: (i) create a defined contribution application for the health plan to allow for the entry of information for the defined contribution plan, the defined contribution plan being either a Health Reimbursement Arrangement (HRA) account or a Flexible Spending Account (FSA) account; (ii) link defined contribution plan information to the health plan; and (iii) establish allocation rules and amounts for the defined contribution plan which comprises, for the HRA, determining whether HRA allocated amounts are to be carried over, and for the FSA, defining parameters including a claim submission method considered during FSA claim processing, as recited in amended independent claims 1, 11, and 22.

Lencki merely discloses a defined contribution strategy allowing the employer to determine a specific dollar allowance per employee to support a core benefit package and set parameters around the modules/options available to the workforce. For their part, the employee would contribute a determined percentage of premium cost sharing and would have an ability to voluntarily contribute pre and after-tax dollars into their individualized Account (Lencki, par. [0081]). The Summary of Benefits selection may be made to display a screen showing the benefit choices that have been made, as well as the pricing, employee contribution, and employer contribution (Lencki, par. [0206]).

Lencki does not teach or suggest establishing allocation rules and amounts for the defined contribution plan which comprises, for the FSA, defining parameters including a claim submission method considered during FSA claim processing, as recited in the claims. *Emphasis added.*

In Lencki, the system merely allows the employer and employee to set their respective contributions. In contrast, in the present invention, the claims delineate defining parameters including a claim submission method wherein, “for example, a member may select to be automatically reimbursed from the FSA for pre-designated items (e.g. co-pays) or a member may select to submit receipts for reimbursement” (See Specification, par. [0081], for further details). Thus, Lencki fails to disclose at least this element of the amended claims.

In addition, Lencki does not teach or suggest establishing allocation rules and amounts for the defined contribution plan which comprises, for the HRA, determining whether HRA allocated amounts are to be carried over, as recited in the amended claims.

In addition, the Examiner alleges that Lencki discloses establishing allocation rules and amounts for the HRA that comprises determining whether HRA allocated amounts are to be carried over, citing to paragraphs [0033] and [0206], and Kaehler teaches an HRA, citing to paragraphs [0033] and [0052]) (Office Action, page 5).

Applicants respectfully disagree.

With respect to Lencki, Lencki merely discloses a high level benefit selector tool process flow (Lencki, par. [0033], Figure 18). As illustrated in Figure 18, the employee enters 1801 the benefit selector tool and may complete 1802 an enrollment screen. The employee may select 1803 a primary physician and configure health benefits 1804, dental insurance benefits 1805, life

insurance benefits 1806, and additional benefits 1807, at which point the selection process may terminate 1808 (Lencki, par. [0175]). Accordingly, since the high benefit selector tool process flow does not teach or suggest determining whether HRA allocated amounts are to be carried over, Lencki does not disclose this element of claims 1, 11, and 22.

Furthermore, Lencki merely discloses a Summary of Benefits selection being made to display a screen showing the benefit choices that have been made, as well as the pricing, employee contribution, and employer contribution (Lencki, par. [0206]). In contrast, HRA allocation rules are used to define a member's HRA allocations, and to allow for the definition of allocation methods and amounts, and whether remaining allocations will carry over to the following year (See Specification, par. [0057], for further details). Since neither the pricing, the employee or employer contribution is the same as determining whether HRA allocated amounts are to be carried over, Lencki fails to disclose, at least, this element of the claims.

As to Kaehler, Kaehler is cited by the Examiner merely because it describes a Health Reimbursement Arrangement (HRA). Kaehler is directed to a very different invention than the invention set forth in Applicant's amended independent claims 1, 11, and 22. Kaehler is directed to a system for benefit management including a server that has an application interface and access to a data store having one or more client files. The client file includes a definable set of business rules for managing and administering benefits and fund use rules for accessing and applying funds to claims from one or more accounts. The system of Kaehler includes a program operable on the server to apply the definable set of business rules in connection with processing a claim. (Kaehler, Abstract).

The combination of Lencki and Kaehler does not teach or suggest, either expressly or inherently, at least: a defined contribution management software module integrated with the health plan management software module, both the health plan management and defined contribution software modules operable by the claim processing system to: (i) create a defined contribution application for the health plan to allow for the entry of information for the defined contribution plan, the defined contribution plan being either a Health Reimbursement Arrangement (HRA) account or a Flexible Spending Account (FSA) account; (ii) link defined contribution plan information to the health plan; and (iii) establish allocation rules and amounts for the defined contribution plan which comprises, for the HRA, determining whether HRA

allocated amounts are to be carried over, and for the FSA, defining parameters including a claim submission method considered during FSA claim processing, as recited in amended independent claims 1, 11, and 22.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. Hodosh v. Block Drug Col, Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). “When determining the patentability of a claimed invention which combined two known elements, ‘the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.’”

Further, as is well known in obviousness determinations, *impermissible hindsight must be avoided*. MPEP § 2141. To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453.

There are significant differences between Lencki and Kaehler and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion of the claimed invention. Accordingly, there is no apparent reason to combine the teachings of Lencki and Kaehler except for hindsight reconstruction, which is impermissible.

Further, Lencki and Kaehler do not expressly or implicitly disclose the elements of independent claims 1, 11, and 22. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Lencki and Kaehler is an obvious application of integrating defined contribution accounts into a claim payment processing system, or an explicit analysis on the apparent reason to combine Lencki and Kaehler in the manner as claimed.

Accordingly, Applicant respectfully requests that the Examiner allow Applicant's amended independent claims 1, 11, and 22, and the claims that depend therefrom, and pass these claims to issuance.

Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 1-4, 6, 7, 10-15, 17, 18, 21-26, 28, 29 and 32 are allowable over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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Dated: 10/2/2008

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